

REMARKS

Claims 1-5 have been examined, and claims 6 and 7 have been withdrawn from consideration. Of the rejected claims, claims 3-5 stand rejected under 35 U.S.C. § 102(e), and claims 1-2 stand rejected under 35 U.S.C. § 103(a).

I. Rejection under 35 U.S.C. § 102(e) over U.S.P. 6,404,728 to Shinozuka et al. (“Shinozuka”)

Claims 3-5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Shinozuka. The Examiner has repeated the previous rejections for essentially the same reasons. In response to the argument that the references fail to teach a lens holder that is “integrally molded” with the connection wires, the Examiner takes the position that “integrally molded” is defined as “to fit closely as a complete unit.” Applicants submit that the claims are patentable over the cited reference.

A. Claim 3

For example, claim 3 states that, in the lens drive device, the lens holder and suspension base are formed on the ends of the wire form elastic members such that the wire form elastic members are embedded within the lens holder and suspension base. In an illustrative, non-limiting implementation of the invention, this feature eliminates the need for adhesives and gels, which are required in Shinozuka, to keep the wire form elastic members correctly positioned and securely fastened within the lens drive device. In Shinozuka, the alleged wire form elastic members 6 are part of a metal members 39 which are adhered to the top and bottom of the alleged lens drive device 36. Clearly, Shinozuka fails to teach or suggest this limitation of claim 3, and thus, the rejection under 35 U.S.C. § 102(e) should be withdrawn.

B. Claim 4

Since claim 4 depends upon claim 3, Applicants submit that it is patentable at least by virtue of its dependency.

C. Claim 5

Since claim 5 contains features that are similar to the features discussed above in conjunction with claim 3, Applicants submit that it is patentable for similar reasons.

II. Rejection under 35 U.S.C. § 103(a) over Shinozuka and Applicants' Prior Art in Figure 1 and pages 7-9 of the specification ("APA")

Claims 1 and 2 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinozuka in view of the APA. Applicants submit that the claims are patentable.

A. Claim 1

With respect to claim 1, the Examiner recognizes that Shinozuka fails to teach or suggest an end of the wire form elastic members buried within teach of the fixing arms. However, he maintains that the APA suggests such features. Moreover, the Examiner concludes that is would have been obvious to modify Shinozuka to have the ends of the wire form elastic members buried within the fixing arms as taught by Applicants' admitted prior art so that the wires stably supported the moving unit while feeding the drive current to the focusing coil and tracking coils and providing enhanced operational reliability in the lens drive unit. Applicants respectfully disagree.

First, the Examiner's rationale for combining the references is not provided in either the Shinozuka reference or the APA. The Examiner is using the rationale provided by Applicants for inventing the claimed invention to support the motivation for combining the cited references.

However, the Examiner's reliance on the very novel rationale provide in Applicants' specification is impermissible hindsight.

Second, the Examiner mistakenly asserts that Shinozuka teaches fixing arms. As explained above, the alleged wire form elastic members 6 of Shinozuka are adhered to the top and bottom surfaces of the lens holder 3. The alleged wire form elastic members 6 are not attached to any fixing arm. Accordingly, even if the APA teaches burying the wire form elastic members in the fixing arms, Shinozuka fails to teach fixing arms. Thus, there could not have been any motivation for burying the alleged wire form elastic members 6 in an element which does not exist in the drive device of Shinozuka.

Finally, Shinozuka teaches away from burying the wire form elastic members in the lens holder. Shinozuka purposely teaches a metal member 39 which is separate from the resin molded member 36. The metal member 39 includes the alleged wire form elastic members 6 held together by a wire holding frame. The wire holding frame is then adhered to the lens holder 3 such that "the holders 3 and 4 and the wires 6 are not directly positioned relative to each other, so that it *is not necessary to bring them into direct engagement with each other.*" (Shinozuka, col. 13:10-15). Clearly, Shinozuka intends to preclude the "direct engagement" of the alleged wire form elastic members 6 with the lens holder 3 and alleged suspension base 4. Thus, Shinozuka actually teaches away from "burying" the alleged wire form elastic member within the lens holder 3 or suspension base 4. It is improper to combine references where one of the references teaches away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP §2145(X)(D)(2). Therefore, we believe that the Examiner has

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/778,015

Attorney Docket No.: Q62980

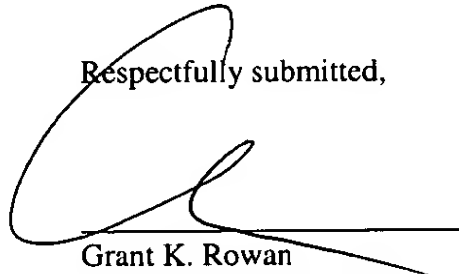
failed to provide a proper motivation to combine the cited references, and as a result, the Examiner has filed to establish a *prima facie* case of obviousness.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Grant K. Rowan
Registration No. 41,278

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 1, 2004